

**REMARKS**

The present amendment is in response to the Office Action dated November 15, 2005. By the present amendment, claims 1, 11, 12, 20, 29, 30, 33, 40, 43, 51, 61 and 62 have been amended. Claims 9, 10, 16, 27, 28, 39, 45, 47, 48, 58, and 60 have been cancelled. Accordingly, claims 1-8, 11-15, 17-26, 29-38, 40-44, 46, 49-57, 59, and 61-66 are pending in the present application. Reconsideration and allowance of pending claims 1-8, 11-15, 17-26, 29-38, 40-44, 46, 49-57, 59, and 61-66 in view of the amendments and the following remarks are respectfully requested.

**A. General Description of Claim Amendments**

The applicant makes the following amendments to the claims:

1. Independent claim 1 is rewritten to incorporate the limitations of dependent claim 9 and dependent claim 10.
2. Dependent claim 11 is amended to correct claim dependency.
3. Independent claim 12 is rewritten to incorporate the limitations of dependent claim 16.
4. Independent claim 20 is rewritten to incorporate the limitations of dependent claim 27 and dependent claim 28.
5. Dependent claims 29 and 30 are amended to correct claim dependency.
6. Independent claim 33 is rewritten to incorporate the limitations of dependent claim 39.
7. Dependent claim 40 is amended to correct claim dependency.
8. Independent claim 43 is rewritten to incorporate the limitations of dependent claim 47 and dependent claim 48.
9. Independent claim 51 is rewritten to incorporate the limitations of dependent claim 60.
10. Dependent claims 61 and 62 are amended to correct claim dependency.

**B. Rejection of claims 1-5, 9-13, 15-17, 33, 34, and 39-41 under 35****USC §103(a)**

In paragraphs 2 and 3 of the office action, the Examiner rejected claims 1-5, 9-13, 15-17, 33, 34, and 39-41 under 35 USC §103(a) as being unpatentable over US Patent No. 6,411,811 ("Kingdon") in view of U.S. Pub. No. 2002/0111171 ("Boesch"). The applicant respectfully submits that the cited references, whether alone or in combination, fail to disclose all the limitations of the claimed invention, and therefore cannot render claims 1-5, 9-13, 15-17, 33, 34, and 39-41 obvious.

**Claims 1-5 and 11**

Independent claim 1 has been amended to incorporate the limitations of dependent claims 9 and 10. Amended claim 1 is a method for providing position assist information from a base station, and has been amended to include the steps of "receiving decoded position information from the GPS enabled device", and "determining a position of the GPS enabled device", as well as "transmitting the determined position to the GPS enabled device". These steps were previously presented in dependent claims 9 and 10.

In rejecting claims 9 and 10, the Examiner cited to Kingdon, col. 5, lines 17-24. However, the applicant respectfully submits that the cited section does not disclose the claimed invention, but teaches a method that is highly undesirable and contrary to the claimed invention. The cited section of Kingdon describes a GPS receiver within a mobile station that "can calculate its position, e.g., latitude and longitude, and send this location information back to the MLC". *Id.* Contrary to amended claim 1, the cited section of Kingdon teaches a mobile station calculating its position, and sending the position to the base station. In contrast, amended claim 1 has the base station "determining a position of the GPS enabled device", and then "transmitting the determined position" from the base station to the device. In this way, the claimed device overcomes the disadvantages of having a full GPS receiver in the mobile device, while still enabling limited burden on the network during an emergency. As stated in the specification as filed:

*"[I]ncluding a full GPS receiver in handset 200 drives up the cost, complexity, and size of device 200 and can also have other negative effects such as reduced battery lifetime" [019].*

*"By incorporating the GPS processing capabilities in PDE 116 instead of device 200, the cost, complexity, and size of device 200 can be reduced while offering enhanced GPS performance due to the greater computational power of the PDE". [022]*

Accordingly, the cited references fail to teach all the limitations of amended claim 1, and instead teach a process that is both undesirable and contrary to the claimed invention. In this way, Kingdon teaches away from the claimed invention, so there would be no motivation to combine the cited references. For these reasons, the applicant respectfully submits that independent claim 1, and its dependent claims, are not rendered obvious by the cited references.

#### Claims 12-13, 15, and 17

Independent claim 12 has been amended to incorporate the limitations of dependent claim 16. Amended claim 12 is a method for receiving position assist information from a base station, and has been amended to include the steps of "transmitting the decoded position information to the base station", and "receiving a position determined ... from the base station". These steps were previously presented in dependent claim 16.

For the reasons similar to those set out above, the applicant respectfully submits that the cited references fail to teach all the limitations of amended claim 12, and instead teach a process that is both undesirable and contrary to the claimed invention. In this way, Kingdon teaches away from the claimed invention, so there would be no motivation to combine the cited references. For these reasons, the applicant respectfully submits that independent claim 12, and its dependent claims, are not rendered obvious by the cited references.

Claims 33, 34, and 40-41

Independent claim 33 has been amended to incorporate the limitations of dependent claim 39. Amended claim 33 is directed to a base station, and has been amended to include a “receiver configured to receive decoded position information from the GPS enabled device”. This structure was previously presented in dependent claim 39.

For the reasons similar to those set out above, the applicant respectfully submits that the cited references fail to teach all the limitations of amended claim 33, and instead teach a structure that is both undesirable and contrary to the claimed invention. For example, the claimed invention has a base station receiver that receives “decoded position information” and as described in the specification, the decoded position information is processed at the base station to determine a location of the mobile device. *See, Specification as filed, paragraph [020]*. In contrast, Kingdon teaches a mobile station that fully calculates its position, and then sends the calculated position information to the base station. In this way, Kingdon teaches away from the claimed invention, so there would be no motivation to combine the cited references. For these reasons, the applicant respectfully submits that independent claim 33, and its dependent claims, are not rendered obvious by the cited references.

**C. Rejection of claims 20-22, 27, and 29 under 35 USC §103(a)**

In paragraph 4 of the office action, the Examiner rejected claims 20-22, 27, and 29 under 35 USC §102(e) as being unpatentable by US Patent No. 6,525,689 (“Dooley”) in view of U.S. Pub. No. 2002/0111171 (“Boesch”).

Claims 20-22 and 29

Independent claim 22 has been amended to incorporate the limitations of dependent claims 27 and 28. Amended claim 22 is a base station, and has been amended to include a receiver configured to “receive decoded position information from the GPS enabled device”, and wherein the base station is

configured to “determine a position of the GPS enabled device”, as well as to “transmit the determined position to the GPS enabled device”. These structures were previously presented in dependent claims 27 and 28.

For the reasons similar to those set out in Section B above, the applicant respectfully submits that the cited references fail to teach all the limitations of amended claim 20, and instead teach a base station that is both undesirable and contrary to the claimed invention. In this way, Kingdon teaches away from the claimed invention, so there would be no motivation to combine the cited references. For these reasons, the applicant respectfully submits that independent claim 20, and its dependent claims, are not rendered obvious by the cited references.

**D. Rejection of claims 6 and 14 under 35 USC §103**

In paragraph 5 of the office action, the Examiner rejected claims 6 and 14 under 35 USC §103(a) as being unpatentable over US Patent No. 6,411,811 (“Kingdon”) in view of U.S. Pub. No. 2002/0111171 (“Boesch”), further in view of US Patent Publication No. 2003/0125046 (“Riley”).

The application submits that claims 6 and 14 are allowable based on their dependency from claims now believed to be in condition for allowance, as more fully set out in the section B.

**E. Rejection of claims 7, 8, 18, 19, 37, and 38 under 35 USC §103**

In paragraph 6 of the office action, the Examiner rejected claims 7, 8, 18, 19, 37 and 38 under 35 USC §103(a) as being unpatentable over US Patent No. 6,411,811 (“Kingdon”) in view of U.S. Pub. No. 2002/0111171 (“Boesch”), further in view of US Patent No. 6,300,899 (“King”).

The application submits that claims 7, 8, 18, 19, 37 and 38 are allowable based on their dependency from claims now believed to be in condition for allowance, as more fully set out in the section B.

**F. Rejection of claims 23, 28, 30, and 31 under 35 USC §103**

In paragraph 7 of the office action, the Examiner rejected claims 23, 28, 30 and 31 under 35 USC §103(a) as being unpatentable over US Patent No. 6,525,689 ("Dooley") in view of U.S. Pub. No. 2002/0111171 ("Boesch"), further in view of US Patent No. 6,411,811 ("Kingdon").

The application submits that claims 23, 30, and 31 are allowable based on their dependency from claims now believed to be in condition for allowance, as more fully set out in the section C.

**G. Rejection of claim 24 under 35 USC §103**

In paragraph 8 of the office action, the Examiner rejected claim 24 under 35 USC §103(a) as being unpatentable over US Patent No. 6,525,689 ("Dooley") in view of U.S. Pub. No. 2002/0111171 ("Boesch"), further in view of US Patent Publication No. 2001/0044312 ("Yamane") and US Patent Publication No. 2003/0125046 ("Riley").

The application submits that claim 24 is allowable based on its dependency from a claim now believed to be in condition for allowance, as more fully set out in the section C.

**H. Rejection of claims 25 and 26 under 35 USC §103**

In paragraph 9 of the office action, the Examiner rejected claims 25 and 26 under 35 USC §103(a) as being unpatentable over US Patent No. 6,525,689 ("Dooley") in view of U.S. Pub. No. 2002/0111171 ("Boesch"), further in view of US Patent No. 6,300,899 ("King").

The application submits that claims 25 and 26 are allowable based on their dependency from claims now believed to be in condition for allowance, as more fully set out in the section C.

**I. Rejection of claim 32 under 35 USC §103**

In paragraph 10 of the office action, the Examiner rejected claims 32 under 35 USC §103(a) as being unpatentable over a combination of US Patent

No. 6,525,689 ("Dooley"), U.S. Pub. No. 2002/0111171 ("Boesch") and US Patent No. 6,411,811 ("Kingdon") in further view of US Patent No. 6,636,740 ("Ramesh").

The application submits that claim 32 is allowable based on its dependency from a claim now believed to be in condition for allowance, as more fully set out in the section C.

**J. Rejection of claims 35, 43, 45-49, 51-54, and 58-65 under 35 USC**

**§103**

In paragraph 11 of the office action, the Examiner rejected claims 35, 43, 45-49, 51-54, and 58-65 under 35 USC §103(a) as being unpatentable over US Patent No. 6,411,811 ("Kingdon") in view of U.S. Pub. No. 2002/0111171 ("Boesch"), further in view of US Patent No. 6,525,689 ("Dooley").

**Claim 35**

The application submits that claim 35 is allowable based on its dependency from a claim now believed to be in condition for allowance, as more fully set out in the section B.

**Claims 43, 46, and 49**

Independent claim 43 has been amended to incorporate the limitations of dependent claims 47 and 48. Amended claim 43 is directed to a GPS enabled device, and has been amended to include a transmitter, and the GPS enabled device is configured to "transmit the decoded position information to the base station", and to "receive a position determined ... from the base station". These structures were previously presented in dependent claims 47 and 48.

For the reasons similar to those set out in Section B above, the applicant respectfully submits that the cited references fail to teach all the limitations of amended claim 43, and instead teach a process that is both undesirable and contrary to the claimed invention. In this way, Kingdon teaches away from the claimed invention, so there would be no motivation to combine the cited

references. For these reasons, the applicant respectfully submits that independent claim 43, and its dependent claims, are not rendered obvious by the cited references.

Claims 51-54, 59, 61-65

Independent claim 51 has been amended to incorporate the limitations of dependent claim 60. Amended claim 60 is directed to a system that has a GPS enabled device, and has been amended so that the GPS enabled device includes a transmitter, and the GPS enabled device is configured to “transmit the decoded position information to the base station”, and to “receive a position determined ... from the base station”. These structures were previously presented in dependent claims 47 and 48.

For the reasons similar to those set out in Section B above, the applicant respectfully submits that the cited references fail to teach all the limitations of amended claim 43, and instead teach a process that is both undesirable and contrary to the claimed invention. In this way, Kingdon teaches away from the claimed invention, so there would be no motivation to combine the cited references. For these reasons, the applicant respectfully submits that independent claim 43, and its dependent claims, are not rendered obvious by the cited references.

**K. Rejection of claim 36 under 35 USC §103**

In paragraph 12 of the office action, the Examiner rejected claim 36 under 35 USC §103(a) as being unpatentable over US Patent No. 6,411,811 (“Kingdon”) in view of U.S. Pub. No. 2002/0111171 (“Boesch”) in view of US Patent Publication No. 2001/0044312 (“Yamane”) and US Patent Publication No. 2003/0125046 (“Riley”).

The application submits that claim 36 is allowable based on its dependency from a claim now believed to be in condition for allowance, as more fully set out in the section B.



**L. Rejection of claim 42 under 35 USC §103**

In paragraph 13 of the office action, the Examiner rejected claim 42 under 35 USC §103(a) as being unpatentable over US Patent No. 6,411,811 ("Kingdon") in view of U.S. Pub. No. 2002/0111171 ("Boesch"), further in view of US Patent No. 6,636,740 ("Ramesh").

The application submits that claim 42 is allowable based on its dependency from a claim now believed to be in condition for allowance, as more fully set out in the section B.

**M. Rejection of claims 44, 55, and 57 under 35 USC §103**

In paragraph 14 of the office action, the Examiner rejected claims 44, 55, and 57 under 35 USC §103(a) as being unpatentable over a combination of US Patent No. 6,525,689 ("Dooley"), U.S. Pub. No. 2002/0111171 ("Boesch") and US Patent No. 6,411,811 ("Kingdon") in further view of US Patent Publication No. 2001/0044312 ("Yamane") and US Patent Publication No. 2003/0125046 ("Riley").

The application submits that claims 44, 55, and 57 are allowable based on their dependency from claims now believed to be in condition for allowance, as more fully set out in the section J.

**N. Rejection of claims 50 and 66 under 35 USC §103**

In paragraph 15 of the office action, the Examiner rejected claims 50 and 66 under 35 USC §103(a) as being unpatentable over a combination of US Patent No. 6,525,689 ("Dooley"), U.S. Pub. No. 2002/0111171 ("Boesch") and US Patent No. 6,411,811 ("Kingdon") in further view of US Patent No. 6,636,740 ("Ramesh").

The application submits that claims 50 and 66 are allowable based on their dependency from claims now believed to be in condition for allowance, as more fully set out in the section J.

**O. Rejection of claim 56 under 35 USC §103**

In paragraph 16 of the office action, the Examiner rejected claim 56 under 35 USC §103(a) as being unpatentable over a combination of US Patent No. 6,525,689 ("Dooley"), U.S. Pub. No. 2002/0111171 ("Boesch") and US Patent No. 6,411,811 ("Kingdon") in further view of US Patent No. 6,300,899 ("King").

The application submits that claim 56 is allowable based on its dependency from a claim now believed to be in condition for allowance, as more fully set out in the section J.

**P. Provisional Double Patenting Rejection**

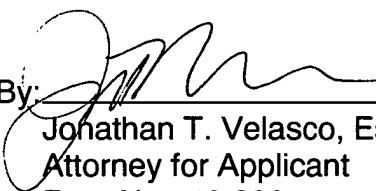
In paragraphs 17-18 of the office action, the examiner provisionally rejected claim 1 under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 9 and 12 of co-pending application no. 10/046,959. The applicant respectfully requests that the Examiner withdraw the provisional rejection, as claim 1 has been amended to incorporate the limitations of claims 9 and 10.

**Q. Conclusion**

For all the foregoing reasons, an allowance of claims 1-8, 11-15, 17-26, 29-38, 40-44, 46, 49-57, 59, and 61-66 pending in the present application is respectfully requested.

Respectfully submitted,

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